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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,972	04/08/2004	Kenneth E. Bailey JR.	030621	9539
41835	7590	07/16/2008	EXAMINER	
K&L GATES LLP			ABU ALI, SHUANQI	
HENRY W. OLIVER BUILDING			ART UNIT	PAPER NUMBER
535 SMITHFIELD STREET				
PITTSBURGH, PA 15222			1793	
MAIL DATE		DELIVERY MODE		
07/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,972	<b>Applicant(s)</b> BAILEY ET AL.
	<b>Examiner</b> SHUANGYI ABU ALI	<b>Art Unit</b> 1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 January 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-35 and 46-50 is/are pending in the application.

4a) Of the above claim(s) 8,9,16,17,24,25,34 and 35 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-7, 10-15, 18-23, 26-33 and 46-50 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

The Examiner overlooked claims 49-50 in the final rejection dated 10/29/2007, therefore, a second non -rejection is presented as following.

***Status of Claims***

Claims 1-7, 10-15,18-23, 26-33 and 46-50 remain for examination wherein claims 1-4, 10-12,18-19,23,26-33 are amended. Claims 46-50 are new.

***Response to Amendment***

The Examiner treats dry-milled flour as dry-milled starch, therefore the amendment filed 09/04/2007 is entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

It is noted that the instant application claims are product-by-process claims.

Eventhough product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 77F.2d 695, 698,227 USPQ 964,966 (Fed. Cir. 1985) (citations omitted).

Claims 1-7, 10-15, 18-23, 26-33, and 46-50 are rejected under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5,766,366 to Ferguson et al. , in view of U. S. Patent No. 4,407,955 to Muller et al.

Regarding claims 1-4, 10-12 and 18-23, Ferguson et al. disclose a process of making an acid modified starch by reacting starch, which can be any kind of starch such as milo and corn (col. 2, lines 25), with hydrochloric acid at a temperature of 21 °C to 77 °C (col. 4, lines 41-42).

But they do not specifically disclose that the starch is made from dry mill process.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use dry mill starch in the Ferguson et al. process, motivated by the fact that Muller et al., also drawn to starch treatment, disclose that starch made from dry mill process is cheap and economic (col. 2, lines 31-41).

Since the acid modified starch of combined teaching of Ferguson et al. and Muller et al. is made by a process substantially identical with the process for making the starch recited in the instant claims. It is reasonably expected that the modified starch of Ferguson et al. and Muller et al. (the fat or protein or viscosity profile) is similar to that of the instant claims absent any evidence to the contrary.

Regarding claims 5-7, 13-15 and 26-33, Ferguson et al. disclose a process of making an acid modified starch by reacting a starch component, which can be any kind of starch such as milo and corn (col. 2, lines 25-30), with an acid component (col. 4, lines 46-50). The acid is hydrochloric acid (col. 3, lines 2 and 3). The reaction is carried out at a temperature of 21 °C to 77 °C (col. 4, lines 41-42) for about 0.5 – 6 hours (col. 5, line 17).

But they do not specifically disclose that the starch is made from dry mill process.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use dry mill starch in the Ferguson et al. process, motivated by the fact that Muller et al., also drawn to starch treatment, disclose that starch made from dry mill process is cheap and economic (col. 2, lines 31-41).

Since the acid modified starch of combined teaching of Ferguson et al. and Muller et al. is made by a process substantially identical with the process for making the

starch recited in the instant claims. It is reasonably expected that the modified starch of Ferguson et al. and Muller et al. (the fat or protein or viscosity profile) is similar to that of the instant claims absent any evidence to the contrary.

Regarding claims 46-50, Ferguson et al. disclose a process of making an acid modified starch by reacting a starch component, which can be any kind of starch (col. 2, lines 7 and 8) and any source of starch such as milo and corn (col. 2, lines 25-30), with an acid component (col. 4, lines 46-50). The acid is hydrochloric acid (col. 3, lines 2 and 3). The reaction is carried out at a temperature of 21 °C to 77 °C (col. 4, lines 41-42) for about 0.5 – 6 hours (col. 5, line 17). But they do not specifically disclose that the starch is made from dry mill process.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use dry mill starch in the Ferguson et al. process, motivated by the fact that Muller et al., also drawn to starch treatment, disclose that starch made from dry mill process is cheap and economic (col. 2, lines 31-41).

Since the acid modified starch of combined teaching of Ferguson et al. and Muller et al. is made by a process substantially identical with the process for making the starch recited in the instant claims. It is reasonably expected that the modified starch of Ferguson et al. and Muller et al. (the fat or protein or viscosity profile) is similar to that of the instant claims absent any evidence to the contrary.

***Response to Arguments***

Applicant's arguments with respect to claims 1-7, 10-15, 18-23, 26-33 and 46-50 have been considered but are moot in view of the new ground(s) of rejection. Newly cited reference teaches that the starch is dry-milled starch.

Regarding claim 10, applicants argue that the composition having a cereal protein content. The Examiner respectfully submits that since the acid-modified starch of Ferguson, which is prepared in a substantially similar manner as that of the instant claims. Therefore, it would be expected the starch composition to have the same properties absent any evidence to the contrary.

Regarding claims 5-7, 13-15 and 26-33, applicant argue that it is hindsight reconstruction to expect the composition having the viscosity profile and flour composition as applicant set forth in the instant application. The Examiner respectfully submits that since the acid modified starch of Ferguson et al. is made by a process substantially identical with the process for making the starch recited in the instant claims. It is reasonably expected that the modified starch of Ferguson is similar to that of the instant claims. If they are any difference, the difference must be minor and obvious. The burden is shifted to applicants to show the final modified starch is different. Furthermore, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shuangyi Abu-Ali whose telephone number is 571-272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793

SA